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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,714	08/09/2006	Kristine Debruyne	22409-00324-US	4670
	7590 09/30/201 STOCKTON LLP	EXAMINER		
1100 Peachtree Street Suite 2800			KAHELIN, MICHAEL WILLIAM	
ATLANTA, GA 30309			ART UNIT	PAPER NUMBER
			3762	
			NOTIFICATION DATE	DELIVERY MODE
			09/30/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipefiling@kilpatrickstockton.com jlhice@kilpatrick.foundationip.com

	Application No.	Applicant(s)
	10/536,714	DEBRUYNE ET AL.
Office Action Summary	Examiner	Art Unit
	MICHAEL KAHELIN	3762
The MAILING DATE of this communication ap Period for Reply	ppears on the cover sheet with the	correspondence address
A SHORTENED STATUTORY PERIOD FOR REP WHICHEVER IS LONGER, FROM THE MAILING I - Extensions of time may be available under the provisions of 37 CFR 1 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory perio - Failure to reply within the set or extended period for reply will, by statu. Any reply received by the Office later than three months after the mail earned patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNICATION I.136(a). In no event, however, may a reply be to divide apply and will expire SIX (6) MONTHS from the cause the application to become ABANDON	ON. imely filed m the mailing date of this communication. IED (35 U.S.C. § 133).
Status		
1) ■ Responsive to communication(s) filed on <u>06.</u> 2a) ■ This action is FINAL . 2b) ■ The Since this application is in condition for allow closed in accordance with the practice under	is action is non-final. ance except for formal matters, p	
Disposition of Claims		
4)	awn from consideration.	ition requirement.
Application Papers		
9) The specification is objected to by the Examir 10) The drawing(s) filed on is/are: a) acceptable and applicant may not request that any objection to the Replacement drawing sheet(s) including the correction of the oath or declaration is objected to by the Examiration.	ccepted or b) objected to by the e drawing(s) be held in abeyance. So ection is required if the drawing(s) is o	ee 37 CFR 1.85(a). bjected to. See 37 CFR 1.121(d).
Priority under 35 U.S.C. § 119		
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the priority application from the International Bure * See the attached detailed Office action for a list	nts have been received. nts have been received in Applica iority documents have been receiv au (PCT Rule 17.2(a)).	ition No ved in this National Stage
Attachment(s) 1) Notice of References Cited (PTO-892)	4) ☐ Interview Summar	ov (PTO-413)
Notice of References Cited (PTO-692) Notice of Draftsperson's Patent Drawing Review (PTO-948) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	4)	Date

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DETAILED ACTION

Election/Restrictions

- **1.** Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 54, 56-65, 70-75, 77-81, and 83, drawn to an implant system having a stop member, classified in class 607, subclass 137.
 - II. Claims 70, 72-75, 77-81, and 83-85, drawn to an implant system having a non-porous cavity and outlet that faces an electrode assembly and forms a boundary of the cavity, classified in class 607, subclass 137.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a non-porous cavity or outlet that faces an electrode assembly and forms a boundary of the cavity. The subcombination has separate utility such as use in a system without a stop, such as one with a collar that freely slides along the elongate member.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all

the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Claim 70 link(s) inventions I and II. The restriction requirement between the linked inventions is **subject to** the nonallowance of the linking claim(s), claim 70. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

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4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and/or examination burden if restriction were not required because at least the following reason(s) apply:

- a. the inventions have acquired a separate status in the art due to their recognized divergent subject matter, and
- b. the inventions require a different field of search (e.g., searching different classes /subclasses or electronic resources, or employing different search strategies or search queries).

Applicant is advised that the reply to this requirement to be complete <u>must</u> include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

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Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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- **5.** A telephone call was made to Michael Verga on 9/24/2010 to request an oral election to the above restriction requirement, but did not result in an election being made.
- 6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL KAHELIN whose telephone number is (571)272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Niketa Patel can be reached on (571) 272-4156. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Kahelin/ Examiner, Art Unit 3762